

## REMARKS

Claims 1-40 are pending in the application. Claims 3, 5, 6, 8-11, 13-18, 20 - 22, 24, 25, and 28-40 are withdrawn from consideration by the Examiner as part of an earlier Restriction Requirement. Claims 1, 2, 4, 7, 12, 19, 23, 26, and 27 are rejected in this Office Action. Claim 1 is rejected under 35 U.S.C. §112 second paragraph. Claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27 are rejected under 35 U.S.C. §102 (a) and (e). Claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27 are rejected under 35 U.S.C. §103(a). Claims 1, 7, 12, 19, 23, and 26 are rejected on the ground of nonstatutory obviousness-type double patenting.

Applicants have canceled claims 7 and 19 without prejudice.

Claims 1 and 26 have been amended to better reflect the invention as exemplified. The amendments do not present new matter and support for such amendment is found in Example 1, [0228].

### Rejection Under 35 U.S.C. §112, First Paragraph

Claim 26 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner finds unclear what "[a] long wearing cosmetic composition" would encompass.

In response claim 26 has been amended to remove the language "long wearing".

Based on the above amendment applicants have removed the grounds for rejection and request that the Examiner allow claim 26.

### Rejections Under 35 U.S.C. §102 (b)

Claims 1, 2, 4, 7, 12, 19, 23, 26, and 27 are rejected under 35 U.S.C. §102 (b) as being anticipated by Patil, *et al* (US 6,342,209B1) ("Patil").

The Examiner alleges that Patil discloses numerous cosmetic compositions containing all of applicants claims ingredients including silicone-acrylate film forming

polymer, volatile linear siloxane, a plasticizer that is the ester of malic acid, satisfying the limitation for multifunctional ingredient and numerous pigments and non-pigmentitious powders.

Applicant respectfully traverses the Examiner's rejection.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

Applicants claim, "[a] cosmetic composition comprising at least one film forming polymer solvated in volatile linear siloxane.

The composition in Patil requires at least one solvent and a plasticizer for the film forming polymer.

Patil does not exemplify or suggest that the film forming polymer and volatile linear solvent without a plasticizer could or would work as a cosmetic composition.

In column 6, lines 62-67, Patil suggests that the makeup composition may contain one or more silicone oils without recognizing that the film forming polymer solvated alone in the silicone oil would have the desired long wearing cosmetic properties of this invention.

It is well settled that a valid patent may issue for a nonobvious improvement on a prior patented invention, even though the improvement falls within the claims of that prior patent (*Corning Glass Works v. Sumitomo Electric USA*, 868 F.2d 1251, 1262, 9, USPQ2d 1962, 1970 (Fed. Cir. 1989).

Applicants argue that the nonobvious improvement in this application removes the anticipation by Patil.

Based on the above-identified facts applicants request the Examiner to withdraw the 35 U.S.C. §102 (b) rejection and allow claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27.

Rejections Under 35 U.S.C. §102 (a) and (e)

Claims 1, 2, 4, 7, 12, 19, 23, 26, and 27 are rejected under 35 U.S.C. §102 (a) and (e) as being anticipated by Calello, *et al* (US 6,485,731 B2) ("Calello").

The Examiner alleges that Calello discloses numerous cosmetic compositions comprising solvents that can be selected from volatile linear siloxanes (including octamethyltrisiloxane when  $n=1$  in formula at col 6 line 45), film-forming polymers (including silicon/acrylate copolymers<sup>0</sup> and several additional ingredients including antioxidants, pigments and suspending agents satisfying lipophilic particulates and plasticizers including glycerol, glycol and citrate esters satisfying the limitation for a multifunctional ingredient. The Examiner additionally states that Calello specifically mentions that more than one film-forming polymer may be employed.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

Applicants claim, "[a] cosmetic composition comprising at least one film forming polymer solvated in volatile linear siloxane.

Applicant respectfully traverses the Examiner's rejection.

Calello specifies that a fluorinated oil be present in combination with the film forming polymer and a solvent (column 2, lines 61 – 64).

In column 6, lines 15-21, Calello suggests that the makeup composition may contain one or more silicone oils without recognizing that the film forming polymer solvated alone in the silicone oil would have the desired long wearing cosmetic properties of this invention.

It is well settled that a valid patent may issue for a nonobvious improvement on a prior patented invention, even though the improvement falls within the claims of that prior patent (*Corning Glass Works v. Sumitomo Electric USA*, 868 F.2d 1251, 1262, 9, USPQ2d 1962, 1970 (Fed. Cir. 1989).

Applicants argue that the nonobvious improvement in this application removes the anticipation by Calello.

A person shall be entitled to a patent unless -

(e) The invention was described in--

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent **by another** filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2)(a) of such treaty in the English language.

An application issued to the same inventive entity cannot be prior art under § 102(e)." *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d 1326, 66 U.S.P.Q.2d 1331 (Fed. Cir. 2003).

The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art. As this court held in *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986):

When the joint and sole inventions are related, as they are here, inventor A commonly discloses the invention of A & B in the course of describing his sole invention and when he so describes the invention of A & B he is not disclosing "prior art" to the A & B invention, even if he has legal status as "another" [35 U.S.C. §102(e)].

*Id.* at 1576, quoting, *In re Land*, 54 C.C.P.A. 806, 368 F.2d 866, 879 (C.C.P.A. 1966).

Even though an application and a patent have been conceived by different inventive entities, if they share one or more persons as joint inventors, the 35 U.S.C. § 102(e) exclusion for a patent granted to "another" is not necessarily satisfied.

Calello is an inventor on this application and US patent 6,485,731 and therefore the 35 U.S.C. § 102(e) exclusion for a patent granted to "another" is not necessarily satisfied.

Based on the above-identified facts applicants request the Examiner to withdraw the 35 U.S.C. §102 (a) and (e) rejections and allow claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27.

#### Rejections Under Double Patenting

Claims 1, 7, 12, 19, 23, and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-14 and 18-20 of copending Application 10/364,245.

The Examiner indicates that the transition phrase comprising in independent claims 1 and 26 does not preclude other ingredients from being present in the compositions mixture.

Applicants have canceled claims 7, 19, and 27 without prejudice. Applicant's have amended claims 1 and 26 by changing transition phrase "comprising" to "consisting of".

The Examiner must provide some clear evidence to establish why the invention's variation in the second patent or application would have been obvious. See *In re Kaplan*, 789 F.2d at 1580, 229 U.S.P.Q. at 683.

In this case, the Examiner has recited a partial list of ingredients found in cosmetics without regard to the complete description of the required combinations of the various ingredients recited and not recited that make these applications separately patentable,

The claims of the Application 10/364,245 require the cosmetic composition to contain polymethylsilsesquioxane, dimethicone and at least one volatile hydrocarbon selected from the group isododecane, isohexadecane, and mixtures thereof.

The subject application does not contain the required hydrocarbons or linear polymer of the 10/364,245 application.

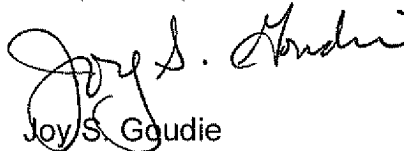
The rejected claims need to be shown to be unobvious in view of the claim(s) upon which they were rejected. See *In re Gladrow*, 406 F.2d 1376 (C.C.P.A. 1969) (holding that unexpected results required reversal of double patenting rejections of some claims); *Pfizer v. Ranbaxy Labs.*, --- F.Supp.2d ---, 2005 WL 3454227 (D.Del. Dec. 16, 2005).

Applicants submit that the subject application and the 10/364,245 application claim different inventions and therefore request removal of the double patenting rejection.

In view of the above amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance and earnestly request such action.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Joy S. Goudie".

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